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August 17, 2006

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Re: **Previous Appeal No.:** 2004-1711  
**Application No.:** 08/889,033  
**Confirmation No.:** 2912  
**Art Unit:** 2621  
**Appellants:** Frazzitta, et al.  
**Title:** Transaction System  
**Docket No.:** D-1083

Sir:

Please find enclosed a Reply Brief pursuant to 37 C.F.R. § 41.41 in response to the Examiner's Answer dated June 30, 2006 for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of this Reply Brief and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke  
Reg. No. 31,029

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D-1083

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

|                                  |   |                 |
|----------------------------------|---|-----------------|
| Previous Appeal No.: 2004-1711   | ) |                 |
|                                  | ) |                 |
| In re Application of             | ) |                 |
| <b>Frazzitta, et al.</b>         | ) |                 |
|                                  | ) | Art Unit 2621   |
| Application No.: 08/889,033      | ) |                 |
|                                  | ) |                 |
| Confirmation No.: 2912           | ) | Patent Examiner |
|                                  | ) | Tung Vo         |
| Filed: <b>July 7, 1997</b>       | ) |                 |
|                                  | ) |                 |
| Title: <b>Transaction System</b> | ) |                 |

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF OF APPELLANTS**  
**PURSUANT TO 37 C.F.R. § 41.41**

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 41.41 concerning the above-referenced Application. This Reply Brief is in response to the Examiner's Answer ("Answer") dated June 30, 2006.

### **REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

## **RELATED APPEALS AND INTERFERENCES**

The Answer includes a "Related Appeals and Interferences section" section on page 2. Appellants respectfully submit that this section is incomplete. A prior decision in this application (as Appeal No. 2004-1711) was rendered by the Board on July 21, 2005. The decision completely reversed the Office.

## **STATUS OF CLAIMS**

Claims 1-47 are pending in the Application.

Claims rejected: 1-44

Claims allowed: 45-47

Claims confirmed: none

Claims withdrawn: none

Claim objected to: none

Claims canceled: none

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The issues presented in this appeal are:

- 1). Whether claims 1-3, 12, 14-16, 18-19, and 38-40 are unpatentable pursuant to 35 U.S.C. § 103(a) as obvious over McClure, et al. (US 3,294,342) in view of Granzow, et al. (US 4,580,040). Hereinafter referred to as "McClure" and "Granzow".
- 2). Whether claims 4-11, 20-23, 28-37, and 41-44 are unpatentable pursuant to 35 U.S.C. § 103(a) as obvious over McClure in view of Granzow and Ramachandran, et al. (US 5,483,047). Hereinafter referred to as "Ramachandran".
- 3). Whether claims 13, 17, and 24-27 are unpatentable pursuant to 35 U.S.C. § 103(a) as obvious over McClure in view of Granzow and Gallacher, et al. (US 5,661,283). Hereinafter referred to as "Gallacher".

## ARGUMENT

The grounds of rejection set forth in the Answer (at pages 3-10) appear to be identical to the grounds previously presented in the Office Action dated October 27, 2005 (at pages 2-10), from which appeal was taken. Thus, Appellants respectfully submit that the rejections set forth in the Answer have already been fully addressed in their Appeal Brief filed on April 10, 2006. Therefore, please note Appellants' previously filed Appeal Brief arguments regarding all the issues of record. Appellants' Appeal Brief of April 10, 2006 is incorporated herein by reference.

### Appellants' Reply to the "Response to Argument" section of the Answer

The Answer includes a "Response to Argument" section beginning on page 11. However, this section provides no new support for the rejections. The Office still has not provided any evidence or factual support for a *prima facie* conclusion of obviousness. Furthermore, the "Response to Argument" section of the Answer only addresses a portion of the many arguments made in support of allowance in the Appeal Brief.

Appellants respectfully disagree with Office's allegations (on Answer pages 11-13). The applied references do not provide teaching, suggestion, or motivation to combine the references to produce the claimed invention; the rejections are based on hindsight reconstruction; and a *prima facie* showing of obviousness has not been established.

The law requires that the *prior art* must set forth a teaching, suggestion, or motivation to combine the prior art teachings in the manner claimed in order to sustain a claim rejection on the basis of obviousness. It is not sufficient to make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Concrete evidence of record (not mere assertions by the Office) must teach or suggest the recited claim features. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d

1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Appellants respectfully submit that the Office has not met these burdens. Nor has the Office conducted the required analysis for a determination of obviousness in accordance with *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The Office has not met the basic criteria for establishing a *prima facie* case of obviousness.

### **Claim 1**

The Answer addresses claim 1 on pages 13-15. Appellants reply to the Answer's remarks regarding claim 1 follow. Most of the Answer's remarks regarding claim 1 merely repeat the allegations already presented in the "Grounds of Rejection" section of the Answer. Thus, Appellants in their Appeal Brief have already fully addressed these remarks.

As admitted by the Office in the rejections, McClure does not teach or suggest the recited customer station in a building. The Answer (on page 15) also states that "Since McClure suggest the banking system having the costumer station (fig. 1) outside the bank, one skill in the art would use the customer station (fig. 1) to build inside the bank for the same purposing of serving a costumer, walking up costumer". The Appellants respectfully disagree.

The Office on one hand can't admit that McClure teaches one manner of structure, and then on the other hand allege that it would be obvious to destroy McClure's specifically disclosed structure and completely rebuild with an opposite manner of structure. The Office's admission that McClure explicitly teaches locating a customer station outside the bank negates locating the customer station inside the bank, especially with the absence of any prior art motivation to do such. The rejection is based on improper hindsight reasoning that uses knowledge gleaned only from Appellants' disclosure. To rely on a reference having a feature that explicitly (and



admittedly) teaches away from the recited invention, for an (undisclosed) opposite teaching of that same feature in order to reject the recited invention is improper. The rejection is based on unsupported allegations instead of prior art evidence of record, which is required to sustain the rejection. *In re Zurko*, supra. *In re Lee*, supra.

Granzow cannot alleviate the admitted deficiencies (and the additionally noted deficiencies as discussed in the Appeal Brief) in McClure. Granzow (like McClure) does not teach or suggest the recited interior customer station (in a building). The Answer alleges that Granzow teaches a customer station (ATM 12). The Answer (on page 15) states that Granzow's "ATM (12 of fig. 1) is . . . mounted inside a bank and interior wall (114 and 146 of fig. 1; col. 6 lines 40-45)". This allegation is not new. This same allegation already appeared in both the Answer (at page 4, lines 17-20) and the Office Action dated October 27, 2005 (at page 4, lines 6-9). Appellants have already shown (in their Appeal Brief) this allegation to be false. For example, the Appeal Brief at page 18 provides reasons why Granzow's ATM (12) cannot constitute the recited customer station. Further, as discussed on Appeal Brief page 45, Granzow teaches a "freestanding" ATM supported by the floor, not an ATM "mounted" in an interior wall, as alleged by the Office. The Office's rehashing of the same false allegation does not make it true. Appellants have shown that neither of the relied upon references (McClure or Granzow) teach or suggest a building having therein the recited customer station. Thus, a *prima facie* case of obviousness has not been established.

The Answer (at page 15, lines 14-17) acknowledges that one skilled in the art would build a customer station *outside* of McClure's building, which is what McClure explicitly teaches. The Answer then, without any supporting evidence of record, alleges that using McClure's same

building technique one would "build both the customer station (fig. 1) and SP station (fig. 5)" inside of McClure's building "for the purpose of serving a walking up customer as suggested by Granzow". The Appellants respectfully disagree.

The reason provided in the rejection (at Answer page 5, lines 1-3) for the alleged modification of McClure with the teaching of Granzow is "for a non-driving customer to do banking without waiting line from a *drive through ATM*". That is, the rejection is predicated on a walk-up customer not having to wait in line at a drive-through exterior ATM. However, this is not a valid reason for the alleged modification because neither McClure nor Granzow even teach or suggest a "drive through ATM". Where does McClure teach any ATM? He doesn't. At best, McClure has a drive-up teller window. If he had the alleged drive-through ATM then he wouldn't need a teller or an SP station. Furthermore, walk-up banking existed before autos were invented. The rejection is improperly based on unsupported and unreasonable allegations.

One having ordinary skill in the art would have recognized that replacing McClure's outside drive-up teller window with an inside teller window would have (at best) resulted in a conventional face-to-face walk-up teller window (without the need for complex display screens, etc.). McClure's complex and expensive teller window is needed only when the customer is outside the building. If the customer is inside the building then there is no need for such a complex and expensive outside teller window. Nor would bank management allow for such a waste of expense. Nor would an inside customer use such an outside teller window when they can use a simpler, faster, and more direct face-to-face walk-up teller window.

The prior art of record (e.g., Ramachandran) also teaches against the Office's proposed changes to McClure. Ramachandran (as discussed in more detail in the Appeal Brief regarding

claim 28) teaches the differences between "freestanding" and "through-the-wall" banking arrangements. Ramachandran teaches that a "through-the-wall" banking arrangement (like McClure's teller arrangement) would not be placed inside a bank building because it is specifically designed to be located at the exterior wall of a bank to enable (walk-up or drive-up) customers to conduct their transactions without entering the bank (col. 1, lines 25-31). That is, Ramachandran teaches that McClure's "through-the-wall" arrangement is limited to the exterior wall of a bank building. In light of the prior art teaching of record (e.g., Ramachandran), one skilled in the art would not have even attempted to move McClure's "through-the-wall" outside arrangement to the inside of McClure's bank building, as proposed by the Office. Ramachandran provides further evidence that it would not have been obvious to one having ordinary skill in the art to have changed McClure in the manner alleged by the Office.

The Answer also ignores the Appeal Brief arguments with regard to the references lacking any teaching or suggestion for the recited structure of the Appellants' SP and customer stations, and the relationship therebetween. The Answer refers to the stations generically and does not address the specifically recited features of the SP and customer stations. These recited station features are also not taught or suggested in the references.

Further, not only are the recited SP and customer stations of claim 1 in the same building, but their respective carrier delivery and receiving devices are in operative connection with each other, enabling a carrier (carrying a transaction item) to be selectively moved therebetween.

As discussed in more detail in the Appeal Brief, Granzow (like McClure) does not teach or suggest the recited SP station in a building. The Answer alleges that Granzow teaches an SP station (14). However, the alleged SP station (14) in Granzow does not include the recited

carrier delivery and receiving device, especially an interior SP station's carrier delivery and receiving device that is in connected relationship with an interior customer station's carrier delivery and receiving device so as to enable selective movement of a transaction item carrier between the two stations. Granzow's arrangement does not enable a carrier carrying a transaction item to be selectively moved between a customer station's carrier delivery and receiving device and an SP station's carrier delivery and receiving device. Granzow does not discuss, mention, or need a carrier. Nor does Granzow's arrangement enable a carrier to be selectively moved. As neither McClure nor Granzow teach or suggest a building having therein an interior customer station *and* an interior SP station (with the SP station's carrier delivery and receiving device enabling carrier movement to the interior customer station), any combination of the references could not have produced the recited invention.

Even if (for sake of argument) it were somehow possible (which it isn't) for Granzow to teach an interior customer station (12) and an interior SP station (14) as alleged by the Office, Granzow would still teach isolation and non connection between the interior stations (e.g., col. 6, lines 41-42), as discussed in the Appeal Brief. That is, Granzow would actually teach against interconnection between an interior customer station and an interior SP station. It follows that Granzow teaches against the recited invention.

As discussed in the Appeal Brief, it would not have been obvious to one skilled in the art to have added Granzow's ATM within McClure's building. Regardless, Granzow's ATM (12) does not constitute the recited interior customer station. Furthermore, even if (for sake of argument) it were somehow possible (which it isn't) for McClure to have an interior ATM, it still would not have been obvious to have located the ATM next to and in functional relation (e.g.,

carrier delivery and receiving devices in operative connection) with the alleged SP station (18) of McClure. Again, note Appellants' Appeal Brief.

Appellants have shown in the Appeal Brief that neither of the relied upon references (McClure or Granzow) teach or suggest a building having therein a customer station with features that include a customer carrier delivery and receiving device from which a carrier carrying a transaction item can be selectively moved; a building having therein an SP carrier delivery and receiving device in operative connection with the customer carrier delivery and receiving device; and the SP station and customer station relationship that enables a carrier with a transaction item to be selectively moved between respective delivery and receiving devices inside of the same building. Nor has the Office shown that it is structurally and functionally possible to have added an ATM within McClure's building, especially when requiring a customer to come inside of McClure's building would go directly against the explicitly disclosed advantages of McClure (as discussed in the Appeal Brief).

Nor is McClure's teaching structurally and functionally compatible with the teaching of Granzow. The alleged customer station (ATM 12) of Granzow is not connectable with the alleged SP station (18) of McClure, especially to enable a carrier to be selectively moved between the alleged stations. The alleged customer station (ATM 12) of Granzow is not even connectable with the alleged SP station (14) of Granzow. Conversely, as previously discussed, Granzow teaches away from the claim by teaching non connection between the alleged stations.

The applied references, taken alone or in combination, do not teach or suggest all of the recited features and relationships. Thus, a *prima facie* case of obviousness has not been established. Nor would it have been obvious to one having ordinary skill in the art to have

modified McClure with the teaching of Granzow as alleged. Even if (for sake of argument) it were somehow possible (which it isn't) for McClure and Granzow to have the features alleged by the Office, and it were even further somehow possible (which it isn't) for the alleged features in McClure to have been modified with the alleged features in Granzow as proposed by the Office, the result still would not have produced Appellants' recited invention.

The Appeal Brief includes even more reasons why the rejection is legally improper. For the many reasons discussed herein and in the Appeal Brief, Appellants respectfully submit that the rejection of claim 1 should be reversed.

#### **Brief review of claim 1 issues**

The following is a short review of some of the claim 1 issues. It should be understood that the Appeal Brief discusses these issues in much more detail. It should also be understood that the Appeal Brief additionally discusses other issues different from those mentioned here.

#### **What the Office alleges the references teach:**

McClure: outside customer station (10).

inside SP station (18).

Granzow: inside SP station (open teller window 14).

inside customer station (ATM 12).

#### **Appellants' rebuttal of the alleged teaching in McClure**

1). McClure doesn't teach or suggest the recited customer station.

1A). Claim 1 recites that "the customer station" is "positioned inside of the building".

Even the Office admits that the alleged customer station (10) of McClure is outside the building.

- 1B). Claim 1 also recites that "the customer station includes therein a customer carrier *delivery* and receiving device". The alleged customer station (10) of McClure can receive a carrier (40) (via a receiver box 38), but where is a teaching that the receiver box can also *deliver* the carrier (40)? In McClure the customer (not a device) has to manually send the carrier (40) on its journey by gravity. Thus, how does the alleged customer station (10) of McClure constitute the recited customer station?
- 2). McClure doesn't teach or suggest the recited SP station. McClure doesn't have an interior station related to an *interior* customer station such that a carrier with a transaction item is enabled to be selectively moved between the stations. Thus, the alleged interior station (18) of McClure cannot constitute the recited SP station.

Appellants' rebuttal of the alleged teaching in Granzow

- 1). Granzow doesn't teach or suggest the recited customer station.
- 1A). The alleged customer station (ATM 12) of Granzow does not enable selective movement of a carrier (like McClure's carrier 40) between stations. That is, Granzow's ATM (12) doesn't include the recited customer carrier delivery and receiving device.
- 1B). Granzow teaches that the ATM (12) is to be isolated from the alleged SP station (14), instead of in operative connection therewith. Granzow teaches against the recited features.
- 2). Granzow doesn't teach or suggest the recited SP station. The alleged SP station of Granzow is actually an open teller window (14) for conventional person-to-person servicing of customers. The teller window (14) of Granzow does not have an SP carrier delivery and receiving device.

Appellants have shown that the Office has not provided prior art evidence of record of all the recited features and relationships. For example, neither of the relied upon references (McClure or Granzow) teach or suggest a building having therein the recited customer station. Thus, a *prima facie* case of obviousness has not been established. It follows that no matter how the references are combined, the end result can't produce the recited invention.

The Office's motivation for modifying McClure, and Appellants' rebuttal thereof:

The Office alleges that it would have been obvious to have modified McClure in view of Granzow's teaching. The Appellants respectfully disagree. As discussed in detail in the Appeal Brief, the reference's teachings are not structurally or functionally compatible with each other. Additionally, the alleged modification of McClure is not a legally proper basis for rejection, as it would destroy the explicitly disclosed structure and function of McClure. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Further, the proposed modification to McClure would destroy his ability to function as McClure requires, rendering McClure non enabling to one of ordinary skill in the art. Because the proposed modification of McClure would not produce an enabled form of what is recited, it is not a legally valid basis for rejection. *In re Kumar*, Case No. 04-1074 Fed. Cir. August 15, 2005. Nor does the evidence of record support a desirability to combine the references, as is required to sustain the rejection. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir. 1990). *In re Fritch*, supra. It would not have been obvious to one having ordinary skill in the art to have modified McClure with the teaching of Granzow as alleged.

The Answer reasons that modifying McClure as proposed would enable "a non-driving customer to do banking without waiting line from a drive through ATM" (Answer at page 5,



lines 1-3). However, this is not a valid reason for the alleged modification of McClure because a "non-driving customer" (i.e., a walk-up customer) has always been able to do banking without use of "a drive through ATM". Walk-up banking existed before autos were invented. Nor has a walk-up customer ever required the Office's proposed changes to McClure in order to perform their banking. The motivation provided by the Office for the proposed modification to McClure is unreasonable and inadequate, and does not constitute a legally valid basis for rejection of the claims.

The Office's alleged result of combining the alleged teachings, and Appellants' rebuttal thereof:

The Office alleges that modifying McClure in view of Granzow would have resulted in the addition of Granzow's ATM (12) inside of McClure's building (Answer page 5, lines 1-3).

As discussed in detail in the Appeal Brief, it would not have been obvious to one having ordinary skill in the art to have added the alleged customer station (i.e., ATM 12) of Granzow to the inside of McClure's building. Nor has the Office shown that it is structurally and functionally possible to have integrated Granzow's ATM (12) in McClure as recited. The alleged SP station (18) of McClure and the ATM (12) of Granzow are structurally and functionally incompatible. The Office remains silent as to how the ATM (12) could move McClure's carrier (40).

Even if it were somehow possible (which it isn't) for Granzow's stand-alone ATM (12) to be added to McClure as alleged, the recited invention still would not have been produced. A missing link between McClure's SP station (18) and the added ATM (12) of Granzow would still remain. For example, there still wouldn't be the recited connected relationship of an interior SP station and an interior customer station (with respective carrier delivery and receiving devices in

operative connection) enabling selective movement of a transaction item carrier between the two interior stations. McClure's carrier (40) could not move between the alleged stations (12, 18).

Although not a part of the actual rejection, the Office for the first time now alleges (in the Answer at page 15) that modifying McClure in view of Granzow's teaching would have resulted (as best understood by Appellants) in having McClure's outside customer station (10) somehow moved into McClure's building.

The Appellants respectfully disagree. It would not have been obvious to one having ordinary skill in the art to have relocated McClure's outside customer station (10) to a location inside of McClure's building. The Office has provided no prior art teaching, suggestion, motivation, or valid reason whatsoever for having McClure's outside customer station (10) inside of his building. Even the Office admits that McClure explicitly teaches keeping the customer station outside of his building. Granzow provides no teaching, suggestion, or motivation for the proposed relocation modification to McClure. Even Ramachandran (as discussed in the Appeal Brief) teaches against the Office's proposed changes to McClure.

Appellants respectfully submit that the proposed change to McClure (which is directly contrary to McClure's explicit teaching) is based purely on improper hindsight reasoning that relies on knowledge gleaned only from Appellants' disclosure. The rejection is absent a prior art teaching showing a link between structurally interconnected SP and customer stations (enabling carrier movement therebetween) *and* the stations both being located inside of the same building.

Even if it were somehow possible (which it isn't) for McClure to move his outside customer station into his building as alleged, the recited invention still would not have been produced. This is because one having ordinary skill in the art would have recognized that the

outside-specific features (designed for a customer in an auto) associated with McClure's customer station are not needed inside the building (as taught by McClure, Granzow, and Ramachandran). Nor is McClure's building sized or outfitted (for safety/health reasons) to enable an auto to be driven therethrough. The outside-specific features would have been left outside. Thus, one having ordinary skill in the art would have stripped the unnecessary outside-specific features from McClure's customer station prior to locating it (if somehow possible) inside the building. The final result would have produced a conventional teller window. Thus, the proposed modification to McClure still wouldn't have resulted in the recited connected relationship of an interior SP station and an interior customer station (having respective carrier delivery and receiving devices in operative connection) enabling selective movement of a transaction item carrier between the two stations.

In conclusion, it would not have been obvious to one having ordinary skill in the art to have modified McClure in view of Granzow to have produced the recited invention.

**Office's acknowledgment of Appellants' complete rebuttal of the Board's comments is noted**

Appellants acknowledge the Examiner's conclusion that "The appellants rebutted the comments by the Board" (Answer page 15, last paragraph). The Board's comments appeared in the decision dated July 21, 2005. The Appellants rebutted the Board's comments in their Appeal Brief and in their letter dated August 10, 2005, both of which are incorporated herein by reference.

Appellants again respectfully submit that the Board's comments are directed to a watered-down (and incorrect) reading of the actual recited features. For example, the Board ignores the features of the recited interior customer station, including its carrier movement relationship with

an interior SP station. Rather, the Board's comments seem to be fixated only on locating *any* customer station inside a building. However, as already discussed in detail in the Appeal Brief, merely having a stand-alone ATM in a bank (like in Granzow) does not anticipate or render obvious Appellants' claims.

As discussed in Appellants' letter dated August 10, 2005, the Board's actions (misreading of claims; addressing issues not on appeal, including accusatory and false statements regarding an awareness of McClure; entreating the Office to reject, and providing extra opportunity therefor) evidence bias against Appellants. Such actions constitute improper Agency action in violation of the Administrative Procedures Act.

### **Claim 38**

Appellants respectfully submit that the Office misinterprets and dilutes the actual claim language. Claim 38 is directed to a building having an interior area with an interior wall. A pneumatic tube SP station is housed in the interior area. A customer station component (from among a customer visual display, customer CCTV camera, customer audio transmitting device, customer audio receiving device, and customer carrier device) is positioned within the interior area and in supporting connection with the interior wall.

The Answer (on page 16) alleges that McClure has a customer station component located *outside* of the building yet somehow also located in "supporting connection with an interior wall" *inside* the building. The Office can't rely on McClure for teaching that a single customer station component is located in two different places (i.e., both outside and inside the same building). The Office admits that McClure's customer station (and all components thereof) are outside the building.

Furthermore, the Answer ignores the total claim language, including having the customer station component be "positioned within the interior area in supporting connection with the interior wall". The Answer doesn't address this "within the interior area" feature. The references don't teach or suggest *both* a pneumatic tube SP station located in a building's interior area *and* a pneumatic tube customer station component located in that same interior area (and additionally positioned in supporting connection with the interior wall while in the interior area). McClure doesn't teach or suggest the features relied upon for the rejection. Granzow can't alleviate the admitted and other noted deficiencies of McClure. Granzow doesn't teach or suggest the SP station, the customer station, or pneumatic tubes. The Office has not established a *prima facie* case of obviousness.

#### **Claim 2**

Claim 2/38 is directed to having both the SP station (and its components) and the customer station (and its components) positioned within the same interior area of a building.

The Office again admits that one skilled in the art would have located McClure's customer station outside of the building. The Office then alleges that the artisan (apparently having a change of skill) would now move McClure's customer station inside of the building. However, there isn't any legal basis or factual evidence of record for the Office's proposed change to McClure. *In re Zurko*, supra. *In re Lee*, supra.

#### **Claims 3, 12, 14-16**

The Answer relies on McClure to allegedly teach the claim 16 feature of "the video switching device is operative to selectively connect the customer visual display to either the

video material presenting device or the SP CCTV camera". The features of claims 3, 12, 14, and 15 are not addressed.

Claim 16 depends from claim 15/14/38. As previously discussed in the Appeal Brief, McClure's SP camera (30) can't be both the recited video material presenting device (of claim 15) and the recited SP camera (of claim 38). Nor can McClure's control panel (60) constitute the recited video switching device. Rather, McClure's control panel (60), at the time of his 1965 filing date, was conventionally limited "to control the volume, light intensity, and other features" (col. 5, lines 26-29). Nor is there any evidence of record that the alleged video switching device (60) in McClure can select between an SP camera (30) output and a video presenting device output to control what a customer sees (via display 29).

Nor can "the amount money that costumer [sic] has in the bank" constitute the recited video presenting device. Nor is there any evidence of record that the customer's visual display (29) in McClure displays the amount of customer money in the bank, as alleged by the Office. Rather, the customer's display (29) is limited to displaying an image of the service operator (col. 3, lines 68-72). The Office has not established a *prima facie* case of obviousness.

### **Claim 18**

Claim 18 depends from claim 2/38. As previously discussed in the Appeal Brief, the references do not teach or suggest *both* the recited customer station and the recited SP station positioned inside the *same* building, especially with the SP station being located inside a secure room of the building and the customer station being located outside the secure room.

As the Office admits, McClure does not teach or suggest a customer station located inside a building, especially located in a building yet outside of a secure room that has an SP station.

Granzow does not teach or suggest an SP station in a *secure* room. Nor does the evidence of record teach or suggest that "a SP station of every bank must be built in a secure [room] in order to protecting tellers", as alleged by the Office. Conversely, in Granzow the public has access to the room in which the alleged SP station (14) is located.

Granzow actually teaches *away* from the recited invention. The alleged customer (12) and SP (14) stations in Granzow are both in the same room. That is, Granzow teaches away from locating the alleged customer and SP stations in different rooms. However, the claim is directed to separating an interior SP station (that is located inside a secure room) from an interior customer station (that is located outside the secure room). The Office has not established a *prima facie* case of obviousness.

#### **Claims 19, 39, and 40**

The Answer alleges that it would have been obvious to move McClure's customer stations inside the bank, at the suggestion of Granzow, so that "a plurality of customer stations are positioned within the interior area of the building" (claim 40). Appellants respectfully disagree for the many reasons already discussed. Claim 40 depends from claim 39/38.

The subject matter of claims 19 and 39 is not addressed in the Answer. As previously discussed in the Appeal Brief, the references don't teach or suggest having plural interior customer stations in operative connection with the same interior SP station (claim 19). Nor do the references teach or suggest plural customer pneumatic tube carrier delivery and receiving devices positioned within the interior area of the building (claim 39), enabling a carrier to be selectively moved between each customer station and the same SP station (claim 40). The Office has not established a *prima facie* case of obviousness.

**Claims 4-11, 20-23, 28-37, and 41-44**

The Answer (on page 19) admits that McClure/Granzow "does not show the details of ATM device as claimed". The Answer (on pages 19-21) then proceeds to repeat verbatim the language already presented in the rejection (at Answer pages 6-7). Thus, the Answer's comments have already been fully addressed in the Appeal Brief.

The Answer (on page 21, lines 9-12) alleges that "Since the ATM of Ramachandran would obvious be *mounted* to the wall, one skill in the art would use the ATM of Ramachandran and the teachings of McClure and Granzow to build the transaction system including the costumer station with the ATM and the SP station inside the same building".

The Appellants respectfully disagree. It would not have been obvious to have mounted Ramachandran's ATM (10) on an interior wall. The rejection is based on pure unsupported assertions. However, the law requires that the evidence of record must teach or suggest the recited features in order to sustain the rejections. *In re Zurko*, supra. *In re Lee*, supra.

The Office misreads the relied upon Ramachandran reference. The relied upon ATM (10) of Ramachandran would not be "mounted" to an interior wall, as alleged by the Office (at Answer page 21, lines 9-10). Appellants already discussed in detail (in their Appeal Brief) differences between "freestanding" and "through-the-wall" types of ATMs. One having ordinary skill in the art would understand that Ramachandran's ATM (10) is a "freestanding" ATM, which Ramachandran himself acknowledges (col. 4, lines 57-58).

Ramachandran specifically teaches away from a freestanding ATM being supported by a wall (especially an interior wall), but instead teaches support by the floor. Nor has the Office provided evidence that an interior wall (e.g., a non load-bearing wall) could support the weight of



Ramachandran's ATM (10). Ramachandran structurally and functionally teaches against the recited customer station.

Thus, a "freestanding" ATM as taught by Ramachandran cannot provide a teaching, suggestion, motivation, or valid reason for a customer station frame to be installed in an opening in an interior wall (or a customer station cover mounted in supporting connection with that same interior wall) (e.g., claim 28), as alleged by the Office. It would not have been obvious to one having ordinary skill in the art to have "mounted" Ramachandran's "freestanding" ATM (10) to an interior wall (as alleged by the Office), and then "use the [mounted] ATM of Ramachandran" to further change the disclosed structure and function of McClure (as further alleged by the Office). A *prima facie* case of obviousness has not been established. Nor would it have been obvious to have modified the references as alleged to have produced the recited invention.

#### **Claims 13, 17, and 24-27**

The Answer (on page 8) admits that McClure/Granzow does not "teach the limitations as claimed". The Answer (on pages 21-24) then proceeds to repeat almost verbatim the language already presented in the rejection (at Answer pages 8-10). Thus, the Answer's comments have already been fully addressed in the Appeal Brief.

#### **Summary**

For reasons presented herein and in the Appeal Brief, the Appellants respectfully disagree with the Office's allegations and reasoning. The Appellants are not required to prove patentability. Appellants respectfully submit that the record lacks the requisite supporting evidence, especially concrete evidence of record, to sustain the rejections. The Office has not established a *prima facie* case of obviousness under the law. It would *not* have been obvious to

one having ordinary skill in the art to have modified McClure as alleged to have produced the recited invention.

More detailed remarks regarding all the issues of record, including support for the patentability of each claim, can be found in the Appeal Brief. Again, attention is directed thereto for additional reasons as to why the references do not render obvious each of the appealed claims.

## CONCLUSION

Each of Appellants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features thereof to produce the recited invention. For these reasons it is respectfully submitted that all of the pending claims are allowable.

Respectfully submitted,



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